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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,950	09/11/2003	Shawn O'Donnell	021863-000100US	7016

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TOWNSEND AND TOWNSEND AND CREW, LLP
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EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,950

Applicant(s)

O'DONNELL, SHAWN

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5-6, 11-12, 17- 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the Election filed 11/01/2007.

Claims 1-4, 7-10 and 13-16 are elected for examination. Claims 5-6, 11-12 and 17-20 are withdrawn from consideration. Claims 1, 7, and 13 are independent claims.

Applicant is required to cancel non-elected claims 5-6, 11-12 and 17-20 in the next response to this office action.

Election/Restrictions

2. Applicant's election traverse of group II (claims 1-4, 7-10 and 13-16) in the reply filed on 11/01/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rawat et al.** (US Patent No. 6662340, filed 05/2002) in view of **Center et al.** (US 2003/0171964, filed 11/13/2001).

As to claim 1:

Rawat teaches a computer-implemented method of processing electronic forms, the method comprising:

- receiving information identifying a first electronic form (*e.g., a typical HTML form ...making an online purchase, or registering at a web site ... then supplying the correct user data; col. 4, lines 28-42 & fig.3 and associated text*);

- determining a set of descriptors associated with a set of fields included in the first electronic form, the set of descriptors including a first descriptor associated with a first field (*col.4, lines 28-62, col. 7, line 41- col. 8, line 67*);
- accessing user information comprising information identifying a set of identifiers stored for a user, the set of identifiers stored for the user including a first identifier corresponding to the first descriptor, wherein a first value is associated with the first identifier (*col. 4, line 43- 62 and col. 5, line 51- col.6, line 39*);
- displaying the first electronic form on a computer display such that the first value is displayed in the first field of the first electronic form (*see fig.1 and the associated text*);
- identifying at least a second descriptor associated with a field in the first electronic form that that does not have a corresponding identifier in the set of identifiers stored for the user (*e.g., Form-filling software generally analyzes the fields 101 of the form and maps them to the correct user data by parsing the HTML field names, commonly known as field tags (not shown) and then supplying the correct user data from a stored user profile, generally located on a remote server ... the fields of the form are populated with the correct user data, without*

reference to a previous, stored mapping or analysis of the form, and without requiring user intervention; col. 4, lines 28-62 and col. 6, line 61-col. 7, line 23);

- determining a second value entered in the field associated with the second descriptor (*col. 4, lines 43-62 and col. 8, line 33-col. 9, line 5*); and
- whereby an identifier corresponding to the second descriptor is include in the set of identifiers stored for the user and the second value is associated with the identifier correspond to the second descriptor (*col. 4, lines 43-67, col. 5, lines 14-32, and figs. 1, 2 & associated text*).

Rawat does not specifically teach updating the set of descriptors.

Center teaches updating the set of descriptors (*see ¶¶ 0043, 0045, 0046, 0051, and 0052*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rawat with Center because it would have provided the capability for automatically filling out fields of forms contained in the document with the appropriate data from a user profile, without requiring prior mapping or examination of the form.

As to claim 2:

Rawat teaches the set of descriptors associated with the set of fields included in the first electronic form includes field names associated with the set of fields and the set of identifiers stored for the user comprises one or more field names associated with the set of fields (*col. 4, lines 43-67, col. 5, lines 14-32, and figs.1, 2 & associated text*).

As to claim 3:

Rawat teaches receiving information identifying a second electronic form (*see fig.1 and see the quick checkout form discussion beginning at col.4, line 28 and col.5, lines 27-32*); determining a set of descriptors (*e.g., field labels, field names*) associated with a set of fields (*e.g., related to its corresponding field*) included in the second electronic form (*e.g., electronic forms*), the set of descriptors including the first descriptor; and displaying the second electronic form on a computer display such that the first information is displayed in the field of the second electronic form associated with the first descriptor (*see fig.2 and the associated text*).

As to claim 4:

Rawat teaches determining a third value entered in the first field of the first electronic form that is different from the first value (*see fig.2*). Rawat, however, does not specifically teach “*updating the user information such that the third value is associated with the first identifier.*”

Center teaches updating the user information such that the third value is associated with the first identifier (*see ¶¶ 0043, 0045, 0046, 0051, and 0052*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rawat with Center because it would have provided the capability for automatically filling out fields of forms contained in the document with the appropriate data from a user profile, without requiring prior mapping or examination of the form.

As to claims 7- 10:

Refer to claims 1- 4 above. Claims 7- 10 are the same as claims 1- 4, except claim 7- 10 are computer program product claims and claims 1- 4 are method claims.

As to claims 13 - 16:

Refer to claims 1-4 above. Claims 13-16 are the same as claims 1-4, except claims 13-16 are system claims and claims 1-4 are method claims. Additionally, Rawat teaches a communication network; a first computer; and a second computer (*see fig.3 and the associated text*).

Response to Arguments

4. Applicant's arguments filed 07/23/2007 have been fully considered but they are not persuasive.

Applicant argues in substance that Rawat does not teach the updating step as claimed [Remarks, page 13].

In response, the Examiner believes the newly applied prior art Center, as combined with Rawat meets the limitations as shown in the rejection above.

Conclusion

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN


WILLIAM BASHORE
PRIMARY EXAMINER